

REMARKS

The Office Action mailed November 17, 2005, has been received and reviewed. Claims 1-67 are currently pending in the application, of which claims 1-11 and 64-67 are currently under examination. Claims 12-63 are withdrawn from consideration as being drawn to a non-elected invention. Claims 1-5, 8 and 64 stand rejected. Claims 6, 7, 9-11 and 65-67 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants respectfully request reconsideration of the application in view of the arguments set forth below.

35 U.S.C. § 102(b) Anticipation Rejections**Anticipation Rejection Based on U.S. Patent No. 5,596,282 to Giddings et al.**

Claims 1-5, 8 and 64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Giddings et al. (U.S. Patent No. 5,596,282). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 is directed to a system for marking integrated circuit (IC) packages. The system comprises: a plurality of trays, each tray being sized and configured to carry a plurality of discrete integrated circuit (IC) packages; a transport actuator; a tray carrier carried by, and unsecured to, the transport actuator for receiving at least one tray of IC packages of the plurality of trays; an input shuttle assembly for providing the at least one tray of IC packages to the tray carrier; an output shuttle assembly for receiving the at least one tray of IC packages from the tray carrier; and a laser marking station disposed adjacent a portion of the transport actuator between the input shuttle assembly and the output shuttle assembly.

The Examiner cites Giddings as anticipating independent claim 1 and states:

Giddings teaches a plurality of trays, each [tray] being sized and configured to carry a plurality of discrete IC packages (figure 1, item 10); a transport actuator (mechanism moving the conveyor belt); a tray carrier, carried by and unsecured to the transport actuator for receiving at least one [tray] of IC packages of the plurality of trays (figure 1, item 14);... an input shuttle for providing the at least one tray of IC packages to the tray carrier (figure 1, item 12) and an output shuttle assembly for receiving the at least one [tray] of IC packages from the tray carrier (figure 1, item 32) and a laser marking station disposed adjacent a portion of the transport actuator between input shuttle assembly and the output shuttle assembly (figure 1, item 30). (Office Action, page 3).

Applicants respectfully disagree with the Examiner's characterization of Giddings and submit that Giddings fails to describe all of the limitations of claim 1.

Giddings discloses a system for testing integrated circuits which includes a first rack (12) that holds trays of integrated circuits (10) and a conveyor (14) that moves trays from the rack along a path through a testing station (16), a rejects/refill station (18) and a laser marking station (20). After marking is completed by the laser marking station, the trays of integrated circuits are placed on another rack (32). (*See, e.g.*, col. 2, lines 25-45)

Giddings fails to describe, however, a *tray carrier carried by, and unsecured to, the transport actuator* for receiving at least one tray of IC packages of the plurality of trays. While the Examiner points to "item 14" of Giddings as satisfying this element, Giddings provides no description of "item 14" other than say that it is a conveyor that takes trays from the first rack (12) and passes them through various stations to the second rack (32). (*See id*). The Examiner appears to assert that Giddings conveyor includes a belt and an actuator for moving the belt. Even assuming *arguendo* that Giddings describes such a conveyor, such an arrangement falls short describing a tray carrier that is both carried by and unsecured to the transport actuator. More specifically, Applicants submit that a conventional conveyor assembly with a drive and a

continuous belt is not the same as a tray carrier that is carried by, and unsecured to, a transport actuator. Applicants, therefore, submit that claim 1 is clearly allowable over Giddings.

Applicants further submit that claims 2 through 5, 8 and 64 are also allowable as being dependent from an allowable base claim as well as for the additional patentable subject matter introduced thereby.

With respect to claim 2 through 5 and 8, Applicants submit that Giddings fails to describe the transport actuator further including a *tray transport* having the *tray carrier* disposed thereon *without securement thereto*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

With respect to claims 3 through 5 and 8, Applicants submit that Giddings fails to describe an upper surface of the *tray transport* and a lower surface of the *tray carrier* as including *mutually cooperative physical structures*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

With respect to claims 4, 5 and 8, Applicants submit that Giddings fails to describe the mutually cooperative physical structures as being adapted to align the *tray carrier* on the *tray transport* when the tray carrier is disposed thereon. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

With respect to claims 5 and 8, Applicants submit that Giddings fails to describe portions of the mutually cooperative physical structures as providing a *fulcrum for tilting of the tray carrier with respect to the tray transport*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

With respect to claim 8, Applicants submit that Giddings fails to describe a *tray transport* that is of lesser longitudinal extent than the *tray carrier*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

With respect to claim 64, Applicants submit that Giddings fails to describe a *tray carrier* that is substantially rectangular and includes a substantially planar upper surface having *upwardly extending stops at each corner thereof*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to describe such subject matter in association with its conveyor.

Applicants, therefore, respectfully request reconsideration and allowance of claims 1 through 5, 8 and 64.

Objections to Claims/Allowable Subject Matter

Claims 6, 7, 9-11 and 65-67 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicants submit that these claims all depend from an allowable base claim and, therefore, are in condition for allowance. Applicants respectfully request reconsideration and allowance of claims 6, 7, 9-11 and 65-67.

CONCLUSION

Claims 1 through 11 and 64 through 67 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Applicants also note that, upon the allowance of generic claim 1, withdrawn claims pending therefrom should also be allowed. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bradley B. Jensen", followed by a long horizontal flourish line.

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Date: February 17, 2006
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Document in ProLaw